Patent
Attorney Docket No. <u>1032326-000139</u>

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	**Mail Stop AF**
)	
Marc Birkner et al.)	Group Art Unit: 2132
)	
Application No.: 09/831,745)	Examiner: Jung W. Kim
)	
Filed: September 20, 2001)	Confirmation No.: 7104
)	
For: METHOD AND DEVICE FOR)	
CONTROLLING A PORTABLE OBJECT)	
LIFE CYCLE, IN PARTICULAR, A)	
SMART CARD)	
)	

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection of claims 1, 3-8, 10-13, 15-23 and 36-38 set forth in the Office Action dated February 15, 2006. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

Background

The claimed subject matter is directed to the control of the life cycle of a portable electronic object, such as a smart card. As illustrated in the example of Figure 6a, during its life cycle the electronic object goes through a number of states, E1-E4 (pages 16-18 of the specification). The claimed subject matter is particularly concerned with avoiding problems of fraudulent initialization, or inadvertent error, as the life cycle transitions from one state to the next.

Referring to Figure 1, to address these concerns the object, e.g. smart card, contains a check engine 9 and a plurality of tables 11-13 that are employed to determine whether a transition from one state to another is permitted, and if so to carry out certain actions associated with that particular transition. The tables are illustrated in more detail in the

example depicted in Figures 6a to 6d. The table of transitions 11, depicted in Figure 6b, indicates whether the transition from the current state to another state is permitted. The check table 12 of Figure 6c indicates the particular checks that are to be performed for a transition from one specific state to another. The table of actions 13, depicted in Figure 6d, indicates the actions to be performed during a given state transition. An example of the checks and actions associated with these tables is described on pages 18-21 of the specification.

The Rejections

Claims 1, 7, 10-17 and 36 stand finally rejected under 35 U.S.C. § 102, on the grounds that they are considered to be anticipated by the Chan et al. patent (US 6,005,942). Claims 3-6, 8 and 18-23 are rejected under 35 U.S.C. § 103, on the basis of the Chan patent in view of secondary references. For the sake of brevity, this Request will focus upon the rejection of independent claims 1, 10, 11 and 12 as being anticipated by the Chan patent.

Claims 1, 10 and 11

Claim 1 recites a device for controlling the life cycle of a portable electronic object that includes, among other elements, a volatile memory, program memories and data memories. These three different memories are respectively identified in Figure 1 as elements 3, 4 and 5. Claim 1 recites that the device comprises a means for controlling the transition from a first state to a second state of the portable object. This device includes, among other elements, "means for checking the content of the volatile memory, the data memories and the program memories of the portable electronic object as a function of the state transition to be effected." One example of this means, therefore, is the check engine 9 in conjunction with the check table 12 and the check programs 67, 68 referenced by that table.

In the Amendment filed January 6, 2006, Applicants pointed out that the Chan patent does not disclose this claimed subject matter. See the paragraph bridging pages 16 and 17 of the Amendment. In response to this argument, the final Office Action states:

> Chan explicitly discloses a feature of the installation of an application into the IC card which meets the limitation in contention: an installed state of an application is achieved when an applet allocates the necessary space and data structure for the operation. (Col. 13: 7-9)

Thus, it appears that the Office Action is taking the position that, the mere act of installing an applet on a smart card, in which space is allocated within memory for the applet, meets the claimed subject matter.

As set forth in MPEP §2131, "to anticipate a claim, the reference must teach *every* element of the claim" (emphasis added). The Chan patent does not meet this requirement. Claim 1 recites that the device for controlling the life cycle of the portable electronic object includes a means for checking the *content* of each of three different memories, namely the volatile memory, the data memories and the program memories of that object. The Chan patent's disclosure of installing an application at column 13, lines 7-9, including the allocation of necessary space in memory, does not teach the claimed subject matter. At best, it only teaches that space is allocated in the particular memory in which the applet is installed, e.g. the program memory. There is no disclosure that, during the installation process, the other memories, i.e. the volatile memory and the data memories, are also checked. Furthermore, there is no disclosure that the *content* of these memories are checked "as a function of the state transition to be effected."

In accordance with the teaching of the present application, by checking the content of these memories as a function of the particular state transition to be effected, fraudulent initialization and/or inadvertent error can be minimized. The Chan patent does not disclose that, during the installation of an applet on a card, these types of checks are carried out to accomplish the same results.

For at least this reason, therefore, the Chan patent fails to meet the requirement for a rejection based upon anticipation. The final Office Action has not shown that the Chan patent discloses *all* of the subject matter recited in the claim.

For the same reasons, claims 10 and 11 are also not anticipated. These two claims recite a portable electronic object and a smart card, respectively, having means for checking the content of the volatile memory, the data memories and the program memories as a function of the state transition to be effected. As discussed in connection with claim 1, the Office Action does not identify such subject matter in the Chan patent.

Claim 12

Claim 12 recites a method of controlling the life cycle of a portable electronic object having a volatile memory, program memories and data memories. These memories have a content that defines a plurality of configurations. Claim 12 recites a method that is implemented "within the object". This method includes, among other steps, that of evaluating checks on the configuration of the object that are associated with a permitted transition. The final step is changing to the new state of the object if two conditions are met, i.e. the requested transition is enabled and the checks on the configuration of the object are satisfied.

In rejecting this subject matter, the final Office Action refers to the Chan patent at Figures 7a and 7b, as well as column 12, lines 43-67, column 16, lines 16-29, and column 17, lines 15-45, with the explanation "card domain validates and modifies the current state."

None of the referenced portions of the Chan patent disclose the step of evaluating checks on the *configuration* of the smart card, particularly checks that are associated with a permitted transition. Rather, the cited passages in the reference are primarily concerned with the mechanism for loading an application on the card. They do not disclose that the configuration of the card, as defined by the content of its memories, is checked as part of the loading process.

Again, therefore, for reasons similar to those presented previously, the Office Action does not meet the requirements for a rejection based upon anticipation. While the Chan patent is directed to the same *general* subject matter as the pending claims, namely the life cycle of a portable electronic object such as a smart card, the claims are not broadly directed to that concept alone. Rather, they recite specific features that provide control over fraudulent initialization or inadvertent error that can occur in the transition between the states of the life cycle. The Office Action has not shown that the *specific* features recited in the claims, as identified above, are taught by the Chan patent.

Conclusion

In summary, the rejection of the claims is based upon generalities, and does not show that the specific features recited in the claims are taught by the Chan patent. As such, it does not establish a record that is appropriate for consideration by the Board of Appeals. In particular, the final Office Action fails to meet the requirement for a rejection based upon anticipation, namely a showing that the Chan patent discloses *all* of the claim limitations. Withdrawal of the rejection is therefore submitted to be in order.

Respectfully submitted,

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